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13 January 2005

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Your Ref : 579779:SDB:PJM

Examiner's first report on patent application no. 93418/01
by NEC CORPORATION

Last proposed amendment no.

Dear Madam/Sir,

I am replying to the request for normal examination. I have examined the application and I believe that there are lawful grounds of objection to the application. These grounds of objection are:

1. The invention defined in Claims 1 & 4 are not novel or inventive when compared with the following prior art documents that disclose all the essential features of the invention claimed:
 - D1: WO 1995/006996 A1 (ERICSSON GE MOBILE COMMUNICATIONS INC.) 9 March 1995.
 - D2: EP 0622933 B1 (NOKIA MOBILE PHONES LTD) 2 November 1994
 - D3: EP 0378775 B1 (MOTOROLA A/S) 5 April 1990

D1 clearly discloses a portable telephone (page 5, line 12-13) with an external memory unit (page 5, lines 13-14), internal memory unit (page 5, line 13), and an external memory connector (page 8, line 22 – page 9, line 2). The portable phone also contains a control unit (page 8, lines 16-17) that can be used to save messages in either the internal or external memory units, as well as a display unit for displaying the location of the information stored in each memory unit (page 8, lines 17-20). The display means also displays information that is memorized in the internal memory unit (page 11, lines 14-16) and the external memory unit (page 18, lines 13-14).

D2 also discloses a portable telephone (page 1, line 15-16) with an external memory unit (page 1, lines 17), internal memory unit (page 1, lines 19-18), and an external memory connector (page 1, line 16 – 17).

Finally, D3 clearly discloses a portable telephone (page 1, line 45) with an external memory unit (page 1, lines 45), internal memory unit (page 1, line 47), and an external memory connector (page 2, lines 30-31). The portable phone also contains a control unit (page 3, lines 36-43) that can be used to save messages in either the internal or external memory units, as well as a display unit for displaying the location of the information stored in each memory unit (page 2, line 27). The display means can also display information that is memorized in the internal memory unit.

2. The invention defined in Claim 2 is not novel and does not involve an inventive step in light of the aforementioned prior art documents D2 & D3.

D2 clearly discloses the ability to transfer information between the internal & external memory units in both directions via a series of predetermined manipulations (page 3, lines 16 – 21 and page 4, lines 9-11).

D3 also clearly discloses the ability to transfer information between the internal & external memory units in both directions via a series of predetermined manipulations (page 3, lines 4 – 12).

3. The invention defined in Claim 2 does not involve an inventive step in light of aforementioned prior art document D1.

The claimed invention differs from the cited art D1 in that it allows information to be transferred between the internal & external memory unit in both directions (i.e. bidirectional) via a series of predetermined manipulations. The cited art discloses the transfer of information from the internal memory unit to the external memory unit in only one direction (i.e. unidirectional) via a series of predetermined manipulations (page 7, lines 1-10).

I consider that this difference constitutes no more than a mere workshop improvement. It is an arrangement that any competent worker in the art would be expected to make directly and without difficulty and by routine steps alone.

4. The invention defined in Claim 3 does not involve an inventive step in light of the aforementioned prior art document D3.

The claimed invention differs from the cited art merely in that it uses different colours to display an information territory for each piece of information in the internal & external memory unit, as opposed to D3 which uses numbers to display the information territory for each piece of information. D3 discloses the use of a pre-designated “abbreviated dial” key to define a memory location in which is stored the number to be dialled (page 2, lines 34-40). As well as this, D3 discloses that memory locations “00-39” are pre-defined as being those that reside in the external memory unit (page 2, lines 40-42), while memory locations “40-99” are predefined as being those that reside in the internal memory unit (page 2, lines 43-45).

I consider that the use of colours, as opposed to the numbers of the cited art (and symbols as is CGK) constitutes no more than a mere workshop improvement. It is an arrangement that any competent worker in the art would be expected to make directly and without difficulty and by routine steps alone.

5. The invention defined in Claim 5 does not involve an inventive step when compared with the aforementioned prior art document D3, in the light of the common general knowledge in the art.

The problem addressed by the current application is how to display the information stored in both the internal and external memory units at the same time utilizing the display means.

The person skilled in the art in this instance would clearly be a manufacturer of electrical devices, in particular portable telephones.

It is common general knowledge in the art of electrical devices (such as personal computers) that display units are capable of displaying information that is stored in various memory units (i.e. hard drives, floppy disks, CR-ROMs, USB drives, etc) all on the same display unit. Since

the 1990's all PCs have been capable of displaying the information stored in each of their attached memory units simultaneously by utilizing separate windows for each of the attached memory units, with PDA's also being capable of such displays. The implementation of two divisional parts (i.e. separate windows) within the same display area to display the information stored in each of the memory units of the portable telephone would be nothing but a matter of routine for a person skilled in the art.

Therefore the person skilled in the art would directly and without difficulty, by routine steps, arrive at a solution which is the same as the claimed solution, and therefore the claimed invention lacks an inventive step.

6. The invention defined in Claim 6 does not involve an inventive step when compared with the aforementioned prior art D3, in the light of the common general knowledge in the art.

The problem addressed by the current application is the storage of text data, sound data, and image data that the portable telephone has transmitted or received.

The claimed invention differs from the cited art in that it stores sound data and image data, as apposed to the citation which discloses the storage of text data alone. However, I consider this feature is well known and considered common general knowledge. It is common general knowledge in the art that memory devices have increased in storage capacity dramatically from the mid-1990's to early 2000, and a person skilled in the art would be able to utilize this increase in memory capacity to store forms of data other than text, such as images (photographs and wallpaper images) and sounds (MP3s and ring tones, polyphonic or otherwise) in both the memory units of the portable phone that have either been transmitted or received.

Therefore the person skilled in the art would directly and without difficulty, by routine steps, arrive at a solution which is the same as the claimed solution, and therefore the claimed invention lacks an inventive step.

You have 21 months from the date of this report to overcome all of my objections otherwise your application will lapse.

You will need to pay a monthly fee for any response you file after 12 months from the date of this report.

You will also need to pay any annual continuation fees that apply. These will normally be first due five years from the filing date. Please note however that earlier commencement dates apply for divisional applications.

Information about fees may be obtained by phoning 1300 651010.

Yours faithfully,



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